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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/656,392

09/05/2003

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MKPA-107US

9588

23122 7590 03/31/2008
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EXAMINER

KERNS, KEVIN P

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

03/31/2008

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TREBOR HEMINWAY, BRIAN MASSEY,
MICHAEL POWERS, and RUSSEL S. SOSSONG

Appeal 2008-2190
Application 10/656,392
Technology Center 1700

Decided: March 31, 2008

Before CHUNG K. PAK, CHARLES F. WARREN, and PETER F. KRATZ,
Administrative Patent Judges.

KRATZ, *Administrative Patent Judge.*

DECISION ON APPEAL

1 This is a decision on an appeal under 35 U.S.C. § 134 from the Examiner's refusal to allow claims 1-7. The claims of the Application have been twice rejected. We have jurisdiction pursuant to 35 U.S.C. § 6.

Appellants' invention is directed to a solder preform that is disclosed as being useful for attaching an optical fiber to a fiber attach pad in an optical system assembly. Claim 1, the only independent claim on appeal, is illustrative and reproduced below:

1. A solder preform for attaching an optical fiber having a diameter to a fiber attach pad, the solder preform comprising a body including solder at least on a bottom surface thereof, the body having a groove extending along a first face from a first end to a second end, the groove being larger in size than the optical fiber to allow alignment of the optical fiber within the groove such that the solder preform is configured to permit alignment of the optical fiber in first and second directions when the groove of the solder preform is placed over the optical fiber,

the body having a length defined as a distance between the first end and the second end, a height defined as a distance between the bottom surface and a top surface opposite the bottom surface, and a width defined as a distance between a third end and a fourth end opposite the third end,

the groove having a height dimension relative to the height of the body and width dimension relative to the width of the body, wherein a ratio of said height dimension to said width dimension is about 1.1:1 to about 1.9:1.

The Examiner relies on the following prior art references as evidence in rejecting the appealed claims:

Enochs	4,702,547	Oct. 27, 1987
Boisgontier	4,984,866	Jan. 15, 1991

Claims 1-6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Boisgontier. Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Boisgontier in view of Enochs.

We reverse both of the Examiner's rejections. Our reasoning follows.

For each of the stated rejections, the Examiner bears the initial burden of presenting a prima facie case establishing the non-patentability of the rejected claims. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Starting with the anticipation rejection, it is well-settled that a prior art reference must disclose every limitation of the claimed invention, either

explicitly or inherently, in order to anticipate a claim. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997).

Here, all of the anticipatorily rejected claims require a solder preform body having a groove therein, which groove is required to be sized such that the height dimension of the groove relative to the width dimension thereof is within a ratio of from about 1.1:1 to about 1.9:1, as set forth in independent claim 1.

The Examiner primarily refers to item (70) of drawing Figure 8 and column 12, lines 16-41 of Boisgontier for an alleged description of a solder preform that corresponds to the here-claimed preform, including the required relative height and width dimensions of the groove (Ans. 2-3). However, like Appellants, we can not locate a description of a solder preform body having a groove with relative dimensions corresponding to Applicants' claimed height dimension to width dimension ratio in Boisgontier, as argued to be there by the Examiner.

This is because the portions of Boisgontier referred to by the Examiner in the Answer do not supply the relative dimensions of a width and height of the arch (70a) of the bridge strip of solder strip (70) depicted in drawing Figure 8 of this applied reference. In this regard, the Examiner has not established that drawing Figure 8 of Boisgontier is drawn to scale and that relative height and width dimensions of the arch can be determined therefrom regardless of which dimension of the arch is assigned as corresponding to the claimed height dimension.

Thus, resolution of the contested claim construction issue, as presented in the Briefs and Answer, respecting which dimensions of the claimed groove in claim 1 correspond to the height dimension and width is

not essential to our non-anticipation determination. However, we note that the Examiner's contention relying on the width of the opening defined by the span of arch portion (70a) of the solder bridge (70) of Boisgontier as corresponding to the claimed solder body groove height dimension is misplaced. This is so because the rise of Boisgontier's arch (70a) corresponds to the here-claimed height dimension of a solder preform body groove, as one of ordinary skill in the art would readily understand. In this regard, the claimed solder body groove and the solder strip arch (70a) of Boisgontier are each configured to be placed over a length of optical fiber. In other words, the fiber covering opening of the claimed groove and the fiber covering opening of the applied solder bridge arch of Boisgontier each extend in a direction substantially perpendicular to and define the "bottom" or fiber covering side/face of the solder body or solder strip, respectively. This assignment orients the claimed "height dimension."

On this record, we reverse the Examiner's anticipation rejection.

Concerning the separate obviousness rejection of dependent claim 7 based on the combined teachings of Boisgontier and Enochs, we note that the Examiner employs Enoch for an asserted teaching with respect to the dependent claim 7 requirement for a glass material. In this regard, the Examiner does not articulate how Enoch in combination with Boisgontier would render the required solder body groove dimensional requirements obvious to one of ordinary skill in the art in the stated rejection (Ans. 4). In light of the above and given that this obviousness rejection is predicated on the Examiner's unproven anticipation assertion that Boisgontier describes a product corresponding to the claim 1 product requirements, we shall also

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reverse the Examiner's stated obviousness ground of rejection of claim 7, as claim 7 depends from claim 1.

ORDER

The decision of the Examiner to reject claims 1-6 under 35 U.S.C. § 102(b) as being anticipated by Boisgontier; and to reject claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Boisgontier in view of Enochs is reversed.

REVERSED

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